

REMARKS

Status of claims

Claims 49, 61, and 86 are amended. Claims 94, 96, 97, 126, and 127 are allowed. Claims 57 and 74 are objected to. Claims 49-62, 64-74, 85-89, 91-92, 94, 96-99, 101, 105, 106, 108, 109, 111, 113, 126 and 127 are in the case.

The Rejections under 112, 2nd paragraph are overcome.

The Action rejects claims 85-89, and 91 under 35 USC 112, 2nd paragraph. All the Examiner's concerns have been addressed, with the exception of claim 87, the rejection of which is traversed.

The term "contoured" that was inadvertently left in claim 85 after being removed by amendment has been removed from the present claim. Applicants appreciate the Examiner pointing out this error and recognizing it as inadvertent.

Claim 86 has been amended to address the Examiner's concern.

Applicants traverse the rejection of claim 87, as antecedent basis for the term "the strut" is found in the last line of claim 85, from which it depends.

All rejections over Sparling and Hawkins should be withdrawn as the references are not combinable and would not reach the claimed inventions even if improperly combined.

The Action rejects claims 49-55, 58, 60, 98-99, 101, 106, 108, and 109 under 35 USC 103(a) as obvious over Sparling ('653) in view of Hawkins ('022). Rather than attempting to make a *prima facie* case of obviousness, the Action merely states that the '653 patent discloses a vehicle and the '022 patent discloses a storage system.

To establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the teachings. Second there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP 2143

Therefore, even if the references were to teach every element of the claimed invention, which they do not, without a motivation to combine the references, there is no *prima facie* case (The Examiner's attention is directed to MPEP 2143.01).

Here, the Action offers no suggestion of any motivation to combine the two references. The Action admits that the '653 patent lacks description of a storage system, but also fails to point out where in the '653 patent there is found any motivation to combine it with a reference disclosing a storage system of any kind, and especially one that falls within the pending claims. Turning to the '022 patent, the Action points to no teaching or suggestion of a vehicle with a driver compartment and a passenger compartment within a single enclosure, nor any motivation to combine the teachings of the patent with the '653 patent.

The Action appears to take the position that because each reference describes a vehicle, that is enough motivation to cherry pick the necessary parts and to re-construct the claimed inventions in hindsight. Applicants do not agree with this position and request that this rejection be withdrawn.

Applicants submit that the two references contain no motivation to combine because the inventors of each had different objectives in their inventions. Turning first to the '653 patent, the objective is to "provide a conversion of lightweight trucks into recreational vehicles with an increase in the capability of seating a number of people." (col. 1 lines 29-31) Nowhere does the '653 patent mention any need for creating a storage system of any kind. The '653 patent actually teaches away from the claimed inventions by describing the need to cut into the wheel well walls in order to make room for the added seats. (col 3, lines 16-20) Since this space is needed for seating, it is unusable for the storage systems of the present claims and thus, the '653 patent teaches away from the invention of the present claims.

Turning to the '022 patent, it in no way suggests an objective in any way related to that of the '653 patent, which is to create a recreational vehicle with additional seating from a light truck. The '022 patent states that it is related to utility trucks adapted for use by electricians and linemen in removing and installing poles for telephone and telegraph wires. The '022 patent states several objectives of its invention, none of which suggest in any way that this disclosure could be combined with the disclosure of a light truck converted to a recreational vehicle as described in the '653 patent.

For example the '022 describes the following objectives of its invention: 1) to provide an improved truck *of this type* capable of carrying a large variety of tools and equipment in an arrangement that facilitates access thereto and economizes in space to increase the carrying capacity of the truck; 2) to construct an improved truck *of this type* in which provision is made to support the longer and heavier elements of certain equipment at a low elevation to lower the center of gravity during transportation and to facilitate loading and removing of these elements; 3) to construct an improved truck *of this type* in which is provided space for relatively long elements of equipment separate from the spaces or compartments for tools and repair materials and parts, without impairing a) the driver's vision; b) the loading and unloading of tools, materials and parts; and c) ready access to other storage spaces; 4) to construct a truck *of this type* in which provision is made to support relatively long and heavy elements of certain equipment on the rigid supporting members of the truck frame so that the exterior frame work may be made of light material in skeleton form and provided with sheet metal walls to form a plurality of compartments; 5) to provide in a truck *of this type* having a plurality of compartments, improved means for simultaneously locking or unlocking the compartments; 6) to provide in a truck *of this type* having a compartment, an improved gage on one wall of the compartment, whereby certain equipment, for example devices stored in said compartment, may be checked before put into use; 7) to provide an improved truck *of this type* having a roof portion mounted to slide endwise whereby certain equipment may be assembled and operated. (col 1, lines 8-51, emphasis added)

Thus the author of the '022 patent explicitly stated in each of the seven objectives that the invention directed only to trucks *of this type*, i.e. utility trucks for use by linemen in installing utility poles. This patent thus teaches away from combining its disclosure with that of a light truck for recreational use. Nor does the '022 suggest any motivation for adding a passenger compartment in a single enclosure with the existing driver compartment as in the present claims.

Because the cited references do not suggest the broader claim 49, they cannot be said to teach or suggest the narrower claims dependent therefrom. For this reason the rejections of the dependent claims are not addressed individually.

The Action has failed to make a *prima facie* case of obviousness, and relies primarily on the '653 patent which has no relevance to the present claims other than

teaching away from the claimed inventions. Applicants request, therefore, that these rejections be withdrawn.

All rejections over Stahl should be withdrawn as Stahl describes a linesmen's utility truck that is not legally combinable with the secondary references and would not teach the claimed inventions if improperly combined.

Claims 61, 62, 64-68, 70-72, 111, and 113 are rejected under 103(a) as obvious over Stahl ('207) in view of Hawkins ('022). The Action again makes no *prima facie* case of obviousness, but rather picks and chooses elements from each reference in an attempt to reconstruct the claimed inventions from hindsight.

Applicants submit, however, that even hindsight reconstruction is impossible with these two cited references, because even in combination these two references do not teach or suggest the type of vehicle of the claimed inventions. Both the '207 and '022 patents describe heavy utility trucks specially designed for use by electrical linemen to install telephone poles. Neither patent suggests in any way that the design of these trucks would be useful or desirable for a light truck or van such as those of the present invention.

For example, the present applicants have defined the term "vehicle" as used in the application at page 8, lines 1-5 to include utility vehicles such as the General Motors "Suburban," sports utility vehicles such as the Ford Bronco or Explorer, and vans (both mini and full size) as exemplified by the Chrysler Caravan, and all similar vehicles. Therefore, the term as used in the patent excludes the type of heavy utility truck used by linemen to set telephone poles as described in the prior art patents.

The cited prior art patents are also completely missing at least one other component of rejected claim 61. Claim 61 includes a rear compartment bounded in part by side panels that accommodate the rear wheel wells as is well known in the types of vehicles covered by that term in the claim. The trucks described in the cited art do not fall within applicants' definition for claimed vehicles, nor do they include the rear compartment as claimed. The only rear compartment that arguably is shown in the prior art is in the '207 patent in which the passenger compartment is close to the front wheel well in the embodiment shown in Figure 1. Claim 61 has been amended to more clearly define that which is considered by applicants to be their invention, which is a storage system adjacent the rear wheel well or wells. This clarification further distinguishes the claims from the '207 and '022 disclosures.

Because the cited references do not teach or suggest the subject matter of the broader claim 61, they cannot be said to teach or suggest the narrower claims dependent therefrom. For this reason the rejections of the dependent claims are not addressed individually.

Applicants submit that the '207 and '022 patents can in no way be said to teach or suggest the subject matter of the rejected claims and respectfully request that these rejections be withdrawn.

All rejections over Hamel should be withdrawn as Hamel is cited merely for the use of a strut.

Claims 85, 86, 89, and 91-92 are rejected as obvious over the either the '207 patent or the '635 patent in view of the '022 patent and Hamel, patent no. D 230,351 ('351).

The '207, '635 and '022 patents have been discussed above and have no more relevance to claim 85 than they did to the previously discussed claims. Any rejections over claim '635 should be withdrawn because this reference does not describe any storage system, nor any need or motivation for providing a storage system of any kind in the described embodiments, and teaches away from the present inventions. Any rejections over the '207 should also be withdrawn as this patent describes a large utility truck designed for a particular use, which is use by linemen crews to set telephone poles, and again does not suggest the rear compartment as claimed in claim 85. The '022 is also a description of a specialized heavy truck for hauling utility poles and has no relevance to the rejected claims.

In light of the lack of an obviousness case based on the primary references, the addition of the '351 reference in no way cures the deficiencies of these rejections. The '351 appears to be cited merely because it shows a strut in the drawings. This is again an attempt to pick and choose parts from any number of disclosures in order to rebuild the invention using the claims as a blueprint. The Action's conclusory statement that it would be obvious to one of skill in the art to provide a storage compartment as taught in Hawkins '022 to the description of Stahl '207 or Sparling '635 has no basis in the references themselves, no indication that the references describe any need or motivation to combine the references, or any indication that any such combination would be successful.

The attempt to provide motivation for combining the strut which was picked as the one element of the '351 reference to use in any rejections is in no way based on the cited prior art. Applicants find no motivation in the cited art for protecting the storage systems from the possibility of rain. The '351 reference is also silent regarding the purpose or motivation for hinging a panel at the top and using a strut for support, and does not indicate in any way that this is for protection against rain.

Because the cited references do not teach or suggest the subject matter of the broader claim 85, they cannot be said to teach or suggest the narrower claims dependent therefrom. For this reason the rejections of the dependent claims are not addressed individually.

Applicants submit that no *prima facie* case of obviousness has been made by the Examiner and respectfully request that these rejections be withdrawn.

The Sparling and Stahl references are not combinable and do not obviate any of the dependent claims.

Claims 56 and 73 are rejected over the '635 or '207 patents in view of the '351 patent. This is again an attempt to add a strut to an already inadequate obviousness rejection. This issue has been addressed in the arguments relative to claim 85 and will not be repeated here.

Applicants request that these rejections be withdrawn.

The Gallagher or Powers patents as applied to dependent claims do not cure the deficiencies in the obviousness rejections of the independent claims.

Claims 59 and 88 are rejected over the previously cited patents, and further in view of Gallagher, applied as teaching a drain/air relief valve.

These dependent claims have been shown to be patentable over the cited art by incorporating all the elements of the independent claims, and thus the addition of the Gallagher reference does not render these claims obvious.

Applicants respectfully request withdrawal of these rejections.

Claims 69 and 73 are rejected over the combination of the '207 patent in view of the '022 and further in view of the '351 patent. These grounds for rejection have been addressed and shown to have no merit. Applicants respectfully request the withdrawal of these rejections.

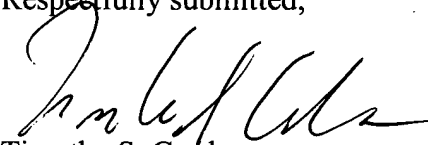
Claim 105 is rejected over the '365 patent in view of the '022 and further in view of Powers ('990). Applicants reiterate that the '365 and '022 patents are irrelevant to, or teach away from the present claims and that the '990 patent does not cure this irrelevancy.

Applicants respectfully request that this rejection be withdrawn.

Conclusion

It is Applicants' belief that the claims are now in condition for allowance and respectfully request that all rejections be withdrawn. If the Examiner has any questions or comments, or believes that certain amendments of the claims would advance this case toward allowance, a telephone call to the undersigned Appellant's representative at (512) 542-8446 is earnestly solicited.

Respectfully submitted,



Timothy S. Corder
Reg. No. 38,414
Agent for Appellant

VINSON & ELKINS
1001 Fannin Street
Suite 2300
Houston, TX 77002-6760
512.542.8446

Date: June 14, 2005